

**REMARKS/ARGUMENTS**

The Office Action mailed May 4, 2006 has been carefully reviewed. Reconsideration of this application, as amended and in view of the following remarks, is respectfully requested. The original application contained claims 1-26. Claims 25-26 stand withdrawn from consideration in this application in response to a restriction requirement. The claims presented for examination are claims 1-24.

**35 USC 102 Rejection**

Claims 1 and 13 were rejected under 35 USC §102(b) as allegedly being anticipated by the Kardish reference (USPN 5,648,047).

Applicant has amended claim 13. Applicant believes the invention claimed in original claim 1 and amended claim 13 is not anticipated by the Kardish reference. The standard for a 35 USC §102 rejection is stated in RCA Corp. v. Applied Digital Systems, Inc, 221PQ 385, 388 (d. Cir. 1984) "Anticipation is established only when a single prior art reference discloses, either expressly or under principles of inherency, each and every element of a claimed invention."

Beginning with amended claim 13, Applicant points out that the following elements of Applicants' amended claim 13 are not found in the Kardish reference:

"a flat disk sample collection pad for exposure to said test location, exposure to said first explosives detecting reagent, and exposure to said second explosives detecting reagent, said flat disk sample collection pad operatively connected to said tester body," or

"an environmental means for receiving said flat disk sample collection pad, said environmental means being a heater or a dryer operatively connected to said tester body for heating or

drying said flat disk sample collection pad and testing the test location for the explosives,” or

Applicant also points out that the following element of Applicants’ original claim 1 are not found in the Kardish reference:

“an environmental unit for receiving said sample collection unit and processing said sample collection unit for testing the test location for the explosives.”

Since the elements described above are not found in the Kardish reference, the Kardish reference does not support a 35 USC §102(b) rejection of Applicants’ original claims 1 and dependent claim 13 and the rejection should be withdrawn.

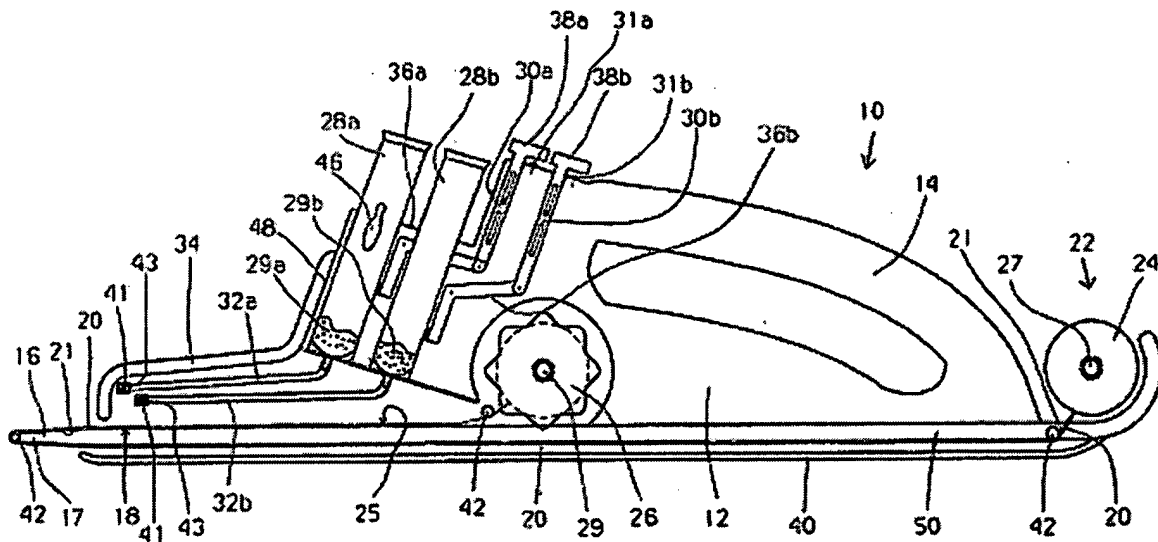
### **35 USC 103 Rejection**

Claims 2-12 and 14-24 were rejected under 35 USC 103(a) as allegedly being unpatentable over the primary Kardish (USPN 5,648,047) in view of the secondary Dietze et al (USPN 5,035,862). Applicants believe that claims 2-12 and 14-24 are patentable and that the Kardish and Dietze et al references would not support a 35 USC §103(a) rejection.

### **The Primary Kardish Reference**

The abstract of the primary Kardish reference describes the device as, “a hand-held device for rapid colorimetric detection of explosives, narcotics, and other chemicals which can be accurately operated by non-skilled personnel and perform numerous tests in a quick sequential manner without exposing a user to hazardous reagents and without exposing sensitive reagents to deteriorating environmental conditions, the device comprising (a) a housing for handling and using the device, the housing including a sampling area and a testing area; (b) a roll of substrate for sampling materials suspected as including the chemical; (b) a feeding reel being rotatably connected to the housing, the feeding reel being for accommodating the roll of substrate; (c) at least one container for accommodating at least one detecting reagent, the at least one detecting reagent

is for the colorimetric detection of the chemical; and (d) at least one dispensing mechanism for dispensing a predetermined volume of the at least one reagent onto the substrate at the testing area." The device is illustrated in FIG. 1 reproduced below.



The primary Kardish reference describes the device as follows:

"Housing 12 further includes a sampling area 16 and a testing area 18, ... Preferably, sampling area 16 is formed as a tip 17 ... a roll 22 of substrate 20 ... Roll 22 of substrate 20 is engaged by a feeding reel 24 which is rotatably connected to housing 12."

"Used segments 25 of substrate 20 are preferably engaged by a take-up reel 26 which is rotatably connected to housing 12, preferably within housing 12. Take-up reel 26 is for advancing substrate 20 and thus the sampled material from sampling area 16 into testing area 18."

"Device 10, further includes at least one, preferably two, more preferably four container 28 (two are shown in FIG. 1, referred to as 28a and 28b) for accommodating at least one detecting reagent 29a and 29b,"

"Device 10 further includes at least one dispensing mechanism 30a and 30b for dispensing a predetermined volume of reagents 29a and 29b, respectively, onto substrate 20 at testing area 18."

"In a preferred embodiment, each of containers 28 is continued by a tube 32a and 32b, respectively, for directing reagents 29 to testing area 18. Each of tubes 32 preferably has a diameter permitting the formation of a capillary effect for effecting the dispensing of the predetermined volume of reagents 29 onto substrate 20 at testing area 18. By having a capillary effect, tubes 32 ensure that

constant volume of liquids (i.e., one drop from each reagent) is delivered onto testing area 18. The quantity (i.e., volume) of liquid in a given drop is a complex function of the diameter of tubes 32, its material of made and the type of liquid. Yet, one can experimentally select tubes 32 permitting application of a particular quantity of reagents 29 onto substrate 20 at testing area 18."

Elements of Claims 2-12 and 14-24 Not Shown by The Kardish Reference

Claims 2-12 depend from original claim 1 and include all the elements of original claim 1. Claims 14-24 depend from amended claim 13 and include all the elements of amended claim 13. The following elements of Applicants' claims 2-12 and 14-24 are not show by the Kardish reference:

"an environmental unit for receiving said sample collection unit and processing said sample collection unit for testing the test location for the explosives." (From Parent Claim 1)

"wherein said environmental unit is a heater." (Claim 2)

"wherein said environmental unit is a dryer." (Claim 3)

"wherein said environmental unit is a heater and dryer." (Claim 4)

"wherein said environmental unit is a chemical heater." (Claim 5)

"wherein said environmental unit is an electric heater." (Claim 6)

"including a heating pad." (Claim 7)

"including a receiving unit for receiving said sample collection unit." (Claim 8)

"including a heating pad and a receiving unit for receiving said sample collection unit." (Claim 9)

"including a battery for providing power to said heater." (Claim 10)

"including a switch for controlling said heater." (Claim 11)

"including a battery for providing power to said heater and a switch for controlling said heater." (Claim 12)

"a flat disk sample collection pad for exposure to said test location, exposure to said first explosives detecting reagent, and exposure to said second explosives detecting reagent, said flat disk sample collection pad operatively connected to said tester body" and "an environmental means for receiving said flat disk sample collection pad, said environmental means being a heater or a dryer operatively connected to said tester body for heating or drying said flat disk sample collection pad and testing the test location for the explosives." (From parent Claim 13)

"wherein said environmental means is a heater." (Claim 14)

"wherein said environmental means is a dryer." (Claim 15)

"wherein said environmental means is a heater and dryer." (Claim 16)

"wherein said environmental means is a chemical heater." (Claim 17)

"wherein said environmental means is an electric heater." Claim 18)

"including a heating pad." (Claim 19)

"including a receiving unit for receiving said flat disk sample collection pad." (Claim 20)

"including a heating pad and a receiving unit for receiving said flat disk sample collection pad." (Claim 21)

"including a battery for providing power to said heater." (Claim 22)

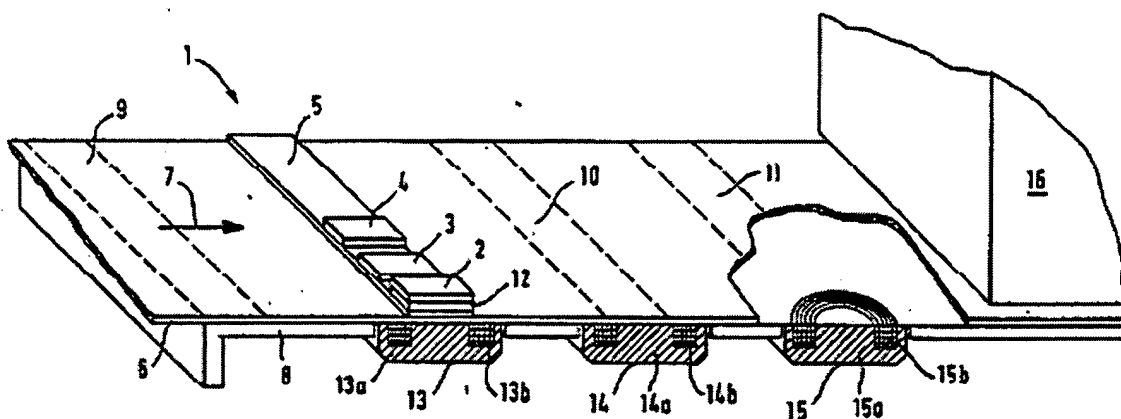
"including a switch for controlling said heater." (Claim 23)

"including a battery for providing power to said heater and a switch for controlling said heater." (Claim 24)

### The Secondary Dietze et al Reference

The secondary Dietze et al reference shows "An analytical system for the determination of a component of a fluid, especially blood or urine." The secondary Dietze et al reference does not mention testing for explosives.

The secondary Dietze et al reference is illustrated by FIG. 1 reproduced below.



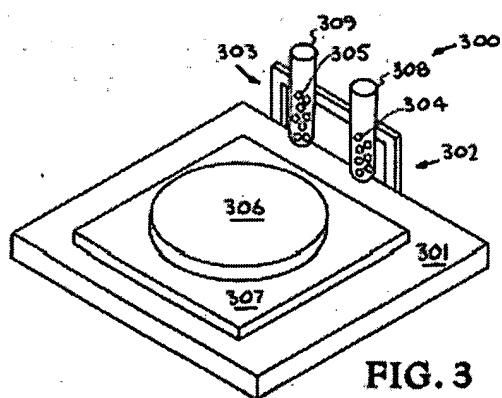
The secondary Dietze et al reference describes the heater(s) as follows:

"Several induction heaters 13, 14 and 15 are embedded in the transport table 8. In each case, they comprise a ferrite core 13a, 14a, 15a and a coil 13b, 14b, 15b. In the area of the induction heater 15, the paper sheet is shown cut open, so that the circular construction of the core and the coil can be seen."

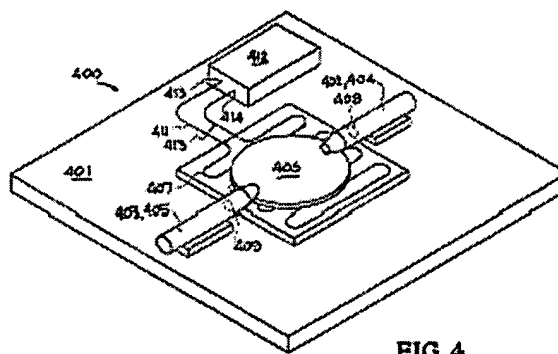
"To heat it to an elevated temperature, the test field must be brought to the working area of an induction heater. In FIG. 1, a magnetic field emanates from the induction heater 13, when an alternating current flows through coil 13b of heater 13. The corresponding test field of a test strip, lying on positions 10 and 11, is in the working area of the alternating magnetic field emanating from the induction heaters 14, 15. Generally the metallic conducting layer 12 has to be in the working area of the magnetic field in the sense that it has to be positioned in the range of that field such that an effective heating is achieved due to the electric current inductively generated by the field. Preferably the distance between the coil 13b and the metal foil 12 should be as short as possible. In practice, a distance of 3 to 5 mm has proven especially satisfactory."

### Applicants' Claimed Invention

Applicants' claimed invention is illustrated in FIGS. 3 and 4 reproduced below.



**FIG. 3**



**FIG. 4**

Applicants' claimed invention is described in original independent claim 1 and amended independent claim 13 as follows:

1. (Original) A tester for testing for explosives associated with a test location, comprising:

- a first explosives detecting reagent;
- a first reagent holder and dispenser, said first reagent holder and dispenser containing said first explosives detecting reagent;
- a second explosives detecting reagent;
- a second reagent holder and dispenser containing said second explosives detecting reagent;
- a sample collection unit for exposure to said test location, exposure to said first explosives detecting reagent, and exposure to said second explosives detecting reagent; and
- an environmental unit for receiving said sample collection unit and processing said sample collection unit for testing the test location for the explosives.

13. (Currently Amended) A tester for testing for explosives associated with a test location, comprising:

- a tester body;
- a first reagent for detecting explosives;
- a first reagent container for receiving said first reagent means;
- a second reagent for detecting explosives;
- a second reagent container for receiving said second reagent means;

a flat disk sample collection pad for exposure to said test location, exposure to said first explosives detecting reagent, and exposure to said second explosives detecting reagent, said flat disk sample collection pad operatively connected to said tester body,

wherein said first reagent container is operatively connected to said body and positioned to deliver said first reagent to said flat disk sample collection pad,

wherein said second reagent container is operatively connected to said body and positioned to deliver said second reagent to said flat disk sample collection pad; and

an environmental means for receiving said flat disk sample collection pad, said environmental means being a heater or a dryer operatively connected to said tester body for heating or drying said flat disk sample collection pad and testing the test location for the explosives.

### **Patentability of Claims 14-24 that Depend from Amended Claim 13**

Beginning with amended claim 13 which is the parent claim of claims 14-24, many of the elements of amended claim 13 are not shown in the references. Also, there is no suggestion or motivation to combine the primary Kardish reference and the secondary Dietze et al reference. Further, there is no teaching in either of the two references to combine the primary Kardish reference and the secondary Dietze et al reference and produce the tester for testing for explosives defined by amended claim 13.

### **Amended Claim 13 Element "a flat disk sample collection pad"**

Amended claim 13 includes the element, "a flat disk sample collection pad for exposure to said test location, exposure to said first explosives detecting reagent, and exposure to said second explosives detecting reagent, said flat disk sample collection pad operatively connected to said tester body."

The primary Kardish reference discloses "a roll 22 of substrate 20 ... Roll 22 of substrate 20 is engaged by a feeding reel 24 which is rotatably connected to housing 12." "Used segments 25 of substrate 20 are preferably engaged by a take-up reel 26 which is rotatably connected to housing 12, preferably within housing



12. Take-up reel 26 is for advancing substrate 20 and thus the sampled material from sampling area 16 into testing area 18.”

Applicants’ amended claim 13 element “a flat disk sample collection pad for exposure to said test location, exposure to said first explosives detecting reagent, and exposure to said second explosives detecting reagent, said flat disk sample collection pad operatively connected to said tester body” is very different from the Kardish “roll 22 of substrate 20 engaged by a feeding reel 24 rotatably connected to housing 12.” Applicants’ claim element would not work in the Kardish reference and would destroy the operability of the Kardish reference device.

The secondary Dietze et al reference does not show Applicants’ amended claim 13 element “a flat disk sample collection pad for exposure to said test location, exposure to said first explosives detecting reagent, and exposure to said second explosives detecting reagent, said flat disk sample collection pad operatively connected to said tester body.” Since both the primary Kardish reference and the secondary Dietze et al reference both fail to show Applicants’ claim element there could be no obvious combination of the two references that would produce Applicants’ invention defined by amended claim 13 and dependent claims 14-24.

#### **Amended Claim 13 and Dependent Claims 14-24**

##### **Element “environmental means being a heater or a dryer”**

Amended claim 13 and dependent claims 14-24 include the elements, “an environmental means for receiving said flat disk sample collection pad, said environmental means being a heater or a dryer operatively connected to said tester body for heating or drying said flat disk sample collection pad.”

The primary Kardish reference completely lacks any reference to a heater or dryer.

The secondary Dietze et al reference shows, "An analytical system for the determination of a component of a fluid, especially blood or urine. ... Several induction heaters 13, 14 and 15 are embedded in the transport table 8. In each case, they comprise a ferrite core 13a, 14a, 15a and a coil 13b, 14b, 15b. ... To heat it to an elevated temperature, the test field must be brought to the working area of an induction heater. In FIG. 1, a magnetic field emanates from the induction heater 13, when an alternating current flows through coil 13b of heater 13. The corresponding test field of a test strip, lying on positions 10 and 11, is in the working area of the alternating magnetic field emanating from the induction heaters 14, 15."

There is no suggestion or motivation to combine the primary Kardish reference device for colorimetric detection of explosives and narcotics and the secondary Dietze et al reference analytical system for the determination of a component of a fluid, especially blood or urine device. The secondary Dietze et al reference does not mention testing for explosives. The Kardish reference device combined with the Dietze et al reference device would destroy the operability of the Dietze et al reference device. Note that in the Dietze et al reference device a magnetic field emanates from the induction heater 13, when an alternating current flows through coil 13b of heater 13. The corresponding test field of a test strip, lying on positions 10 and 11, is in the working area of the alternating magnetic field emanating from the induction heaters.

There is no teaching in either of the two references to combine the primary Kardish reference and the secondary Dietze et al reference and produce the inspection tester for testing for explosives defined by amended claim 13 and dependent claims 14-24.

### **Missing Elements of Applicants' Claims 1-12**

The following elements of Applicants' original claims 1-12 are not shown by the references:

"an environmental unit for receiving said sample collection unit and processing said sample collection unit for testing the test location for the explosives." (From Parent Claim 1)

"wherein said environmental unit is a heater." (Claim 2)

"wherein said environmental unit is a dryer." (Claim 3)

"wherein said environmental unit is a heater and dryer." (Claim 4)

"wherein said environmental unit is a chemical heater." (Claim 5)

"wherein said environmental unit is an electric heater." (Claim 6)

"including a heating pad." (Claim 7)

"including a receiving unit for receiving said sample collection unit." (Claim 8)

"including a heating pad and a receiving unit for receiving said sample collection unit." (Claim 9)

"including a battery for providing power to said heater." (Claim 10)

"including a switch for controlling said heater." (Claim 11)

"including a battery for providing power to said heater and a switch for controlling said heater." (Claim 12)

### **No Suggestion or Motivation to Modify or Combine References**

Applicants submit there is no suggestion or motivation to modify the primary Kardish reference to include the many missing claim elements that have been identified. The Dietze et al reference shows a system that is substantially different from the system shown in the Kardish reference.

Since both the primary Kardish reference and the secondary Dietze et al reference both fail to show Applicants' claim elements there could be no obvious combination of the two references that would produce Applicants' invention defined by original claims 1-12.

There is no suggestion in the two references to modify the primary Kardish reference to include the many missing claim elements identified above.

Under MPEP §2142, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. It should be noted that the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaack, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Since there is no suggestion or motivation to modify the primary Kardish reference to include the many missing claim elements identified above, a rejection of Applicants' claims 2-12 and 14-24 under 35 USC §103(a) is not be appropriate and should be withdrawn.

### **Double Patenting**

Claims 1-24 were provisionally rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1-27 of co-pending Application 10/610,904 and claims 1-21 of co-pending Application 10/703,303.

### **Co-pending Application 10/610,904**

The co-pending Application 10/610,904 and the subject application are commonly owned. The co-pending application co-pending Application 10/610,904 and the subject application are owned by The Regents of the University of California. The fact that the co-pending application co-pending

Application 10/610,904 and the subject application are owned by The Regents of the University of California is established by assignments recorded in the United States Patent and Trademark Office.

In the Office Action mailed May 4, 2006, it was stated, "A timely filed terminal disclaimer in compliance with 37CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application...."

Enclosed herewith is a terminal disclaimer in compliance with 37 CFR 1.321(c), disclaiming the terminal portion of any patent issue from this application which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173 of co-pending Application 10/610,904.

Co-pending Application 10/703,303

The co-pending Application 10/703,303 and the subject application are not commonly owned.

The subject application is owned by The Regents of the University of California which is shown by an assignment recorded in the United States Patent and Trademark Office.

The co-pending application 10/703,303, filed November 7, 2003, and published as Publication No. US 2005/0101027, is an application that was filed by Jeffery S. Haas after he left the employment of the University of California and has not been assigned to The Regents of the University of California.

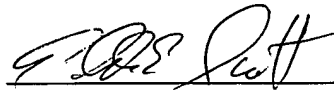
Since the co-pending Application 10/703,303 and the subject application are not commonly owned, an obviousness type double patenting rejection is not appropriate and should be withdrawn.

Applicants believe they have provided a full and complete response to the provisional obviousness-type double patenting rejections in the Office Action mailed May 4, 2006.

SUMMARY

The undersigned respectfully submits that, in view of the foregoing amendments and the foregoing remarks, the rejections of the claims raised in the Office Action dated May 4, 2006 have been fully addressed and overcome, and the present application is believed to be in condition for allowance. It is respectfully requested that this application be reconsidered, that the claims be allowed, and that this case be passed to issue. If it is believed that a telephone conversation would expedite the prosecution of the present application, or clarify matters with regard to its allowance, the Examiner is invited to call the undersigned attorney at (925) 424-6897.

Respectfully submitted,



Eddie E. Scott  
Attorney for Applicant  
Registration No. 25,220  
Tel. No. (925) 424-6897

Livermore, California

Dated: August 9, 2006